

REMARKS

This application has been reviewed in light of the Office Action dated October 18, 2004. Claims 1-22 are presented for examination, of which Claims 1, 7, 10, 16, 19, and 20 are in independent form. Claims 1, 7, 10, 15, 16, 19, and 20 have been amended to define more clearly what Applicant regards as his invention, and Claims 2-6, 8, 9, 11-14, 17, and 18 have been amended as to matters of form. Favorable reconsideration is requested.

Claims 7, 8, 16, 17, 20, and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by WIPO Publication No. WO 99/14909 (*Chalmers et al.*); and Claims 1-6, 9-15, 18, 19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chalmers et al.*, in view of U.S. Patent No. 6,073,142 (*Geiger et al.*).

As shown above, Applicant has amended independent Claims 1, 7, 10, 16, 19, and 20 in terms that more clearly define what he regards as his invention. Applicant submits that these amended independent claims, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The rejection of independent Claims 1, 10, and 19 will be discussed first.

The aspect of the present invention set forth in Claim 1 is a communicating apparatus. The communicating apparatus includes a receiving unit, an obtaining unit, a storage unit, a discriminating unit, and a control unit. The receiving unit receives E-mails stored in a mail box provided on an E-mail server, and the obtaining unit obtains a size of an E-mail stored in the mail box. The storage unit stores a maximum value of the size of an E-mail which is to be received by the receiving unit. The discriminating unit compares

the size of the E-mail obtained by the obtaining unit with the maximum value stored in the storage unit, thereby discriminating whether or not the E-mail is receivable. The control unit controls the receiving unit so as not to receive an E-mail discriminated by the discriminating unit as being not receivable, sends an instruction to E-mail server to delete the E-mail, and stores into a communication history that the E-mail has been deleted.

Among other notable features of Claim 1 is that a control unit controls the receiving unit so as not to receive an E-mail discriminated by the discriminating unit as being not receivable, sends an instruction to E-mail server to delete the E-mail, and stores into a communication history that the E-mail has been deleted. By virtue of this structure, it is possible to eliminate the reception of E-mails which are not receivable and deleting those E-mails from the E-mail server. Accordingly, computing resources are not spent on trying to receive E-mails that are not receivable, thereby increasing the performance of the E-mail receiving operation. Further, because the communication history stores information regarding the deletion of these E-mails, a user is able to know of the existence of those E-mails that could not be received.

Chalmers et al. relates to electronic mail systems. In the *Chalmers et al.* system, an E-mail received from an E-mail server is transferred to its intended destination. The size of the E-mail is obtained in step 303 of Figure 3, and if the size of the E-mail exceeds a threshold (step 304 of Figure 3) a part of the E-mail message is extracted (step 340 of Figure 3). At step 341 of Figure 3, message filter 2 creates a reference message containing a reference to the location and identity of the stored part of the message in store 6, and at step 342, the message filter 2 sends the reference message to each intended destination of the message. In the *Chalmers et al.* system, an E-mail is received from the

E-mail server, even in a case where the size of the E-mail exceeds a threshold value. In contrast, in the invention as recited in Claim 1, an E-mail which exceeds the maximum value for size is not received from the E-mail server and is also deleted from the E-mail server.

Applicant has found nothing in *Chalmers et al.* that would teach or suggest a control unit controlling the receiving unit so as not to receive an E-mail discriminated by the discriminating unit as being not receivable, sending an instruction to E-mail server to delete the E-mail, and storing into a communication history that the E-mail has been deleted, as recited in Claim 1.

Further, the Office Action correctly states that *Chalmers et al.* fails to disclose deleting an E-mail that is not receivable.

For at least the above reasons, Applicant submits that Claim 1 is clearly patentable over *Chalmers et al.*, taken alone.

Applicant submits that a *prima facie* case of obviousness has not been made out as to Claim 1. A *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's own disclosure (M.P.E.P. § 2143). Further, if the proposed modification or combination of the prior art would change the principle of

operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Geiger et al. is cited in the Office Action as remedying the deficiencies of *Chalmers et al.* *Geiger et al.* relates to defining business rules that implement business communication policies for controlling the handling of E-mail messages and other data objects by a data server. *Geiger et al.* discusses deleting an email as a result of a business rule in an automated post office.

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of *Chalmers et al.* with that of *Geiger et al.* by deleting an E-mail that is not receivable.

As discussed above, the *Chalmers et al.* system sends a reference message containing a reference to the location and identity of the stored part of the message, which exceeded the threshold, in store 6 to each intended destination of the message. Therefore, if the deleting feature of the *Geiger et al.* system were to be combined with the *Chalmers et al.* system, the modified *Chalmers et al.* system would not generate and send the reference message to each intended destination of the E-mail. Thus, if *Chalmers et al.* is modified in the way suggested by the Office Action, such modification would impermissibly change the principle of operation of *Chalmers et al.* Applicant submits, therefore, that a *prima facie* case of obviousness has not been made out.

Independent Claims 10 and 19 are method and computer program claims respectively corresponding to apparatus Claim 1, and are believed to be patentable over

Chalmers et al. and *Geiger et al.* for at least the same reasons as discussed above in connection with Claim 1.

The rejection of independent Claims 7, 16, and 20 will now be addressed.

The aspect of the present invention set forth in Claim 7 is a communicating apparatus. The communicating apparatus includes an obtaining unit, a selection unit, a receiving unit, and a control unit. The obtaining unit obtains size information for each of a plurality of E-mails stored in a mail box provided on an E-mail server. The selection unit selects a receivable E-mail on the basis of the size information obtained by the obtaining unit. The receiving unit receives an E-mail selected by the selection unit from the E-mail server, and the control unit controls the receiving unit so as not to receive an E-mail which was not selected by the selection unit from the E-mail server.

Among other notable features of Claim 7 are selecting a receivable E-mail on the basis of the size information obtained by the obtaining unit, and controlling the receiving unit so as not to receive an E-mail which was not selected by the selection unit from the E-mail server. By virtue of this feature, it is possible to receive only E-mails that are receivable and not to receive E-mails that are not receivable, based on the size information of the E-mail. Thus, computing resources are not spent on trying to receive E-mails that are not receivable, thereby increasing the performance of the E-mail receiving operation.

As discussed above, in the *Chalmers et al.* system, an E-mail is received from an E-mail server is transferred to its intended destination. In the *Chalmers et al.* system, all E-mails are received, irregardless of their size. Applicant has found nothing in *Chalmers et al.* that would teach or suggest selecting a receivable E-mail on the basis of

the size information obtained by the obtaining unit, and controlling the receiving unit so as not to receive an E-mail which was not selected by the selection unit from the E-mail server. By virtue of this feature, it is possible to receive only E-mails that are receivable, not to receive E-mails that are not receivable, based on the size information of the E-mail, as recited in Claim 7.

For at least the above reason, Applicant submits that Claim 7 is clearly patentable over *Chalmers et al.*

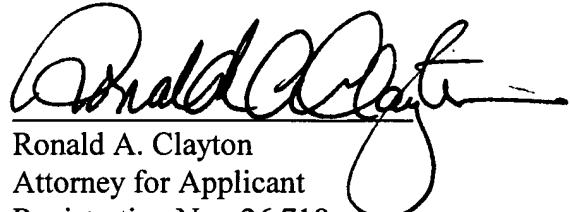
Independent Claims 16 and 20 are method and computer program claims respectively corresponding to apparatus Claim 7, and are believed to be patentable over *Chalmers et al.* for at least the same reasons as discussed above in connection with Claim 7.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



Ronald A. Clayton
Attorney for Applicant
Registration No.: 26,718

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 476388v1